

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

	ATTY. DOCKET NO.: GAMETECH.004003C
IN RE APPLICATION OF:	§
	§
MARK P. LOWELL	§ EXAMINER: CARLOS, ALVIN LEABRES
	§
SERIAL NO.: 10/698,862	§ CONFIRMATION NO.: 9353
	§
FILED: NOVEMBER 3, 2003	§ ART UNIT: 3715
	§
FOR: ENHANCED BINGO GAME	§
METHOD, APPARATUS,	§
AND COMPUTER	§
PROGRAM PRODUCT	§
	§

**APPEAL BRIEF UNDER 37 C.F.R. §41.37**

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 27-52 and 55 in the above-identified application. A Notice of Appeal was filed in this case on December 8, 2008. Please charge the fee of \$270.00 due under 37 C.F.R. §41.20(b)(2) for filing the brief to **Dillon & Yudell LLP Deposit Account No. 50-3083.**

## **REAL PARTY IN INTEREST**

The real party in interest in the present Application is Gametech International, Inc., the Assignee of the present application as evidenced by the Assignment set forth at reel 015287, frame 0457.

## **RELATED APPEALS AND INTERFERENCES**

There are no Appeals or Interferences known to Applicant, Applicant's legal representative, or assignee, which would be directly affected or have a bearing on the Board's decision in the present Appeal.

## **STATUS OF CLAIMS**

Before the Final Action of October 8, 2008, Applicant had canceled Claims 1-26, 53, 54, and 56-79. Claims 27-52 and 55 are pending in the application and stand rejected. Applicant appeals the rejections of Claims 27-52 and 55.

## **STATUS OF AMENDMENTS**

No amendments to the claims have been made subsequent to the final rejection.

## **SUMMARY OF THE CLAIMED SUBJECT MATTER**

Independent Claim 27 recites a method of playing a game of bingo. The method involves “(a) designating a set of potential numbers for the game; (b) designating a plurality of subsets of the potential numbers for the game; (c) associating each of the plurality of subsets with at least one bingo card column; [and] (d) providing at least one bingo card to at least one player, the bingo card including a plurality of spaces, the spaces being arranged in a matrix of rows and columns, wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator.” See ¶¶ [0021]-[0023]. The method further includes “(e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a

column of spaces on the bingo card; (f) providing at least a first set of colors; [and] (g) associating each of the first set of colors with a win enhancement value.” See ¶ [0023].

The method of independent Claim 27 further calls for “(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column.” See ¶ [0020]. The method also involves “(i) repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends; [and] (j) paying [ . . . ] a win value if [ . . . ] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern.” See Fig. 2 (item 230) and ¶ [0052]. The method further calls for “(k) paying, in addition to the win value, a first bonus [ . . . ] wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.” See Fig. 2 (item 235) and ¶¶ [0044] and [0052].

Dependent Claim 28, depending from Claim 27, calls for “selecting at least one number at random from each of the subsets to serve as a win enhancement activator; and paying [ . . . ] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.” See ¶ [0050].

Dependent Claim 29, depending from Claim 27, additionally involves “designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card.” See ¶ [0047]. Claim 29 also includes “providing a set of graphics; associating each of the set of graphics with a win enhancement value; [and] associating at least one of the set of graphics to rows on the bingo card.” See ¶ [0048]. Claim 29 further recites “paying a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, wherein the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.” See Figure 2 (item 240) and ¶ [0052].

Claim 31, depending from Claim 29, calls for “selecting at least one number at random from each of the subsets to serve as a win enhancement activator; paying [ . . . ] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator; and paying [ . . . ] the second bonus only if the pattern formed by the matching numbers

contains at least one win enhancement activator.” See ¶¶ [0053], [0055].

Independent Claim 55 is directed to a method of playing a bingo game. The method involves “(a) designating a set of potential numbers for the game; (b) designating a plurality of subsets of the potential numbers for the game; (c) associating each of the plurality of subsets with at least one bingo card column; [and] (d) providing at least one bingo card to at least one player, the bingo card including a plurality of spaces, the spaces being arranged in a matrix of rows and columns, wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator.” See ¶¶ [0021]-[0023]. The method further includes “(e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card; (f) providing at least a first set of colors; [and] (g) associating each of the first set of colors with a win enhancement value.” See ¶ [0023].

The method of independent Claim 55 additionally calls for “(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column.” See ¶ [0020]. The method also involves “(i) designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card.” See ¶ [0047]. The method also includes (j) providing a set of graphics; (k) associating each of the set of graphics with a win enhancement value; [and] (l) associating at least one of the set of graphics to rows on the bingo card.” See ¶ [0048].

The method of Claim 55 also involves “(m) selecting at least one number at random from each of the subsets to serve as a win enhancement activator.” See ¶ [0050]. The method calls also for “(n) repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends.” See Figure 2 (item 230).

The method of Claim 55 additionally provides “(o) paying [ . . . ] a win value if [ . . . ] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern.” See ¶¶ [0023], [0047], [0048], [0052], [0053]. The method also calls for “(p) paying, in addition to the win value, a first bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern, and if the pattern formed by

the matching numbers contains at least one win enhancement activator, wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.” See ¶¶ [0044], [0050], [0052]. The method of Claim 55 further involves “(q) paying, in addition to the win value, a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.” See ¶¶ [0048], [0052], [0053], and [0055].

**GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL**

Applicant requests review of the final rejection of Claims 27-52 and 55 as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Nos. 6,220,596 and 5,727,786.

## ARGUMENTS

### I. Principles of Law

Applicant notes that to support a finding of “obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art.” *Ex parte Newcomb*, Bd. of Pat. App. and Int. (March 31, 2008), citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); see also, *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all the elements in a claim.”). Moreover, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)).

### II. Grouping of Claims

For the purposes of the arguments below, Claims 27-52 and 55 will be grouped as follows:

- a) Claims 27, 32, 33, and 37-49;
- b) Claims 28;
- c) Claims 29, 30, 34-36, and 50-52;
- d) Claim 31; and
- e) Claim 55.

Each group will be argued separately, and the claims of each group above stand or fall together.

### III. The Examiner’s final rejection of Claim 27 under 35 U.S.C. § 103(a) should be reversed because the prior art cited does not teach or render obvious each and every limitation of Claim 27.

At page 2 of the Final Office Action (“FOA”), the Examiner rejected Claims 27, 32, 33, and 37-49 as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,220,596 to Horan (“Horan”) and U.S. Patent No. 5,727,786 to Weingardt (“Weingardt”). For the reasons presented

below, Applicant respectfully disagrees with the rejection and asks that the Examiner's rejection be reversed.

Independent Claim 27 recites a method of playing a game of bingo. The method involves, *inter alia*:

- (c) associating each of [a] plurality of subsets [of potential numbers] with at least one bingo card column;
- [. . .]
- (e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;
- (f) providing at least a first set of colors;
- (g) associating each of the first set of colors with a win enhancement value;
- (h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column; [and]
- (j) paying [. . .] a win value if [. . .] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern;
- (k) paying, in addition to the win value, a first bonus [. . .] wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.

The Examiner takes the position that the Horan-Weingardt combination teaches or renders obvious all the features of Claim 27 listed above. In particular, the Examiner posits that Weingardt shows "associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column." (*FOA* at page 3). As evidence for his position, the Examiner points to the following two excerpts of Weingardt.

In the conventional manner of play of bingo, in order to win the game, a player must cover five spaces in a vertical column, a horizontal row or along one of the two diagonals of the bingo card. The free space in the center of the bingo card allows a player to win with as few as four numbers being drawn. Other winning combinations include the four corners of the bingo card and the eight numbers immediately adjacent and surrounding the free space. Winning combinations can also include the covering of spots on the bingo card so that letter symbols are formed such as an X, U, L, H or T.

(*Weingardt* at Column 1, lines 31-40.)

The electronic controls that operate the electronic bingo board illuminate the selected "blue" numbers as the color "blue", the selected "green" numbers as the color "green" and the selected "red" numbers as the color red. The remaining numbers are left as "yellow" which is the initial color of all the numbers on the electronic reader board. Each player can then see at the beginning of a game which of the bingo numbers have the various distinctive markings.

(*Id.* at Column 5, lines 26-33.)

Nothing in the excerpts of Weingardt quoted above explicitly teaches "*associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column,*" as recited by Claim 27. Applicant submits that Weingardt addresses itself, in relevant part, only to the notion that certain colors are associated with certain randomly selected numbers, not columns. In fact, Weingardt explains that "an electronic random number generator selects a predetermined group of bingo numbers to be 'blue'[,] a slightly larger predetermined group of bingo numbers to be 'green' numbers[, and] a still larger predetermined group of bingo numbers to be 'red' numbers. All of the other remaining numbers are 'yellow' numbers for [a] particular game of bingo." *Id.* Column 3, lines 35-48.

In response to Applicant's arguments that Weingardt does not teach or render obvious "*associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column,*" the Examiner responds with variations of a single argument:

Since Weingardt positively teaches a bingo game that utilizes colors, numbers and grouping. The grouping would utilize and identify by colors, ranges, patterns and position/location on the bingo card including but not limited to column and rows. It would have been obvious [...] to modify Horan in view of Weingardt to substitute any type of grouping that utilizes both colors, numbers and patterns in order to provide additional features to the bingo game that allows for more jackpot opportunities and payouts. (*FOA* at pages 10-11.)

Thus, in effect, the Examiner argues that since the game of bingo involves patterns and numbers (as taught by Horan), and since Weingardt associates colors with groups of numbers, then any combination, grouping, or association of colors, patterns, and numbers would be obvious. Applicant respectfully disagrees.

Applicant submits that it is improper for the Examiner to select only those portions of a prior art reference that seem to address Applicant's claimed subject matter without taking into

consideration the entirety of the teaching of the prior art reference. More specifically, according to *In re Ratti*, a prima facie case of obviousness cannot be established if a “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the prior art] as well as a change in the basic principle under which the [prior art] construction was designed to operate.” 270 F.2d at 813 (CCPA 1959); *See also* Manual of Patent Examination Procedure (MPEP) 2143.01 V (“the proposed modification cannot render the prior art unsatisfactory for its intended purpose.”); MPEP 2143.01 VI (“the proposed modification cannot change the principle of operation of a reference.”). Moreover, a reference that teaches away from the claimed subject matter cannot support a prima facie case of obviousness.

Applicant submits that Weingardt teaches away from Applicant’s claimed subject matter as recited in Claim 27. Claim 27 recites, among other things, “(c) associating each of [a] plurality of subsets [of potential numbers] with at least one bingo card column; [and] (h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column.” In contrast, Weingardt merely discloses associating colors with randomly selected numbers. See, for example, Weingardt at Column 5, lines 26-33. Hence, the thrust of Weingardt, focusing on the association of a color with a group of numbers, is precisely opposite to Applicant’s claimed subject matter of associating a color with a column “without regard to the associated subset of potential numbers for the at least one column.” (Emphasis added). Thus, at least in this regard, Weingardt leads away from the subject matter of Applicant’s Claim 27.

Moreover, the recitation in Claim 27 for “associating at least one of the first set of colors to at least one column,” and then “associating each of [a] plurality of subset of [potential numbers] with at least one bingo card column,” effectively means that a group of numbers, associated, with the same column, will also be associated with the same color. In contrast, in Weingardt the individual numbers of a subset of numbers associated with a given column will not be associated with the same color, except under a statistically possible coincidence that numbers chosen at random for association with a given color also happen to be associated with the same bingo card column. Thus, the modification of Weingardt to arrive at Applicant’s Claim 27 would require an impermissible “change in the basic principle under which [Weingardt] was

designed to operate.” *In re Ratti*. For at least this additional reason, Applicant submits that Weingardt teaches away from the subject matter of Claim 27.

Addressing more specifically the Examiner’s apparent argument that in the game of bingo any combination, grouping, or association of colors, patterns, and numbers would be obvious—a simple matter of design choice—Applicant submits the following. The basic bingo game as generally known in the art provides multiple dimensions for possible variability. Not only is it possible to create variations along features mentioned by the Examiner (such as indicia (color or graphic for example), pattern, and number grouping), but also by location on a given card and timing of certain events, to name a couple more features. If all the possible combinations (i.e., variations) to color, graphic, patterns (column, row, diagonal, corners, letter T), and number groupings are used, the unique number of combinations possible is in the hundreds of thousands of possible variations of a standard bingo game. The number of combinations can be determined using a standard formula from combinatorial mathematics, which can be found at <http://en.wikipedia.org/wiki/Combinations>. Therefore, Applicant submits that the subject matter of Claim 27 cannot be dismissed on the ground of being a simple matter of design choice when the number of “design choices” is potentially in the hundreds of thousands. Applicant submits that the Examiner must provide a more robust rationale for finding Claim 27 obvious.

In fact, Applicant respectfully points out that the Examiner has yet to provide a logical line of reasoning as to what in the knowledge of one of ordinary skill in the prior art would lead that person to logically modify the Horan-Weingardt combination to arrive at the subject matter of Claim 27. The Examiner’s offered rationale for modifying the prior art amounts to generalized and conclusory assertions that there would be motivation to combine Horan with Weingardt because providing additional features to a standard bingo game would be desirable for both players and bingo game operators. (*See FOA* at pages 10-11, for example.) Applicant submits that such thin rationale falls far short of the standard required by *In re Kahn*: “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. (emphasis added).

Claims 32, 33, and 37-49 depend directly or indirectly from Claim 27. Consequently, Applicant submits that at least for the reasons offered above Claims 32, 33, and 37-49 are also not rendered obvious by Horan and Weingardt, singly or in combination.

Therefore, Applicant submits that neither Horan nor Weingardt, singly or in combination, can support an obviousness rejection of Claims 27, 32, 33, and 37-49, and consequently, Applicant requests that the Examiner's rejection of Claims 27, 32, and 37-49 be reversed.

**IV. The Examiner's final rejection of Claim 28 under 35 U.S.C. § 103(a) should be reversed because the prior art cited does not teach or render obvious each and every limitation of Claim 28.**

At page 3 of the *FOA*, the Examiner rejected Claim 28 as obvious over Horan and Weingardt. For the following reasons, Applicant submits that Claims 28 is allowable over the references of record.

Dependent Claim 28, depending from Claim 27, calls for "*selecting at least one number at random from each of the subsets to serve as a win enhancement activator; and paying [.] . . . the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.*" The Examiner takes the position that Weingardt teaches this feature of Claim 28. (*FOA* at page 4.) The Examiner relies on Weingardt at Column 4, line 50 through Column 6, line 3. The Examiner then concludes that "[i]t would have been obvious to [.] . . . to modify Horan's invention in view of Weingardt in order to provide an additional features [sic] added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased player participation and additional revenues." (*FOA* at page 4.)

At Column 4, line 50 through Column 6, line 3, Weingardt merely describes that colors are associated with numbers, and that different colors have different payout values. Applicant submits that nowhere does Weingardt teach or render obvious "*selecting at least one number at random from each of the subsets to serve as a win enhancement activator[,] and paying [a] bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator,*" as recited by Claim 28 (emphasis added). Applicant submits that choosing a number at random, from each of a plurality of subsets of numbers, to serve as a win enhancement activator is not the same, nor is it rendered obvious by, assigning a color to a group of randomly selected numbers, which color can serve as a win enhancer.

The Examiner's proffered rationale as to why a person of ordinary skill in the art would be led to modify Horan-Weingardt to arrive at the subject matter of Claim 28 is merely a generalized statement of a benefit to be derived if the modification were made. As far as

Applicant can discern, the Examiner appears merely to assert that Weingardt's association of colors and groups of randomly selected numbers makes obvious all other variations of bingo involving colors or numbers. Applicant submits that such broad and generalized basis of rejection cannot be sustained.

Therefore, Applicant submits that Claim 28 is allowable over the references of record, and respectfully requests that the Examiner's rejection of Claim 28 be reversed.

**V. The Examiner's final rejection of Claim 29 under 35 U.S.C. § 103(a) should be reversed because the prior art cited does not teach or render obvious each and every limitation of Claim 29.**

At page 4 of the *FOA*, the Examiner rejected Claim 29 as obvious over the Horan-Weingardt combination. For the following reasons, Applicant respectfully disagrees with the rejection and asks that the Examiner's rejection be reversed.

Dependent Claim 29, depending from Claim 27, additionally involves:

*designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;*

*providing a set of graphics;*

*associating each of the set of graphics with a win enhancement value;*

*associating at least one of the set of graphics to rows on the bingo card, and*

*paying a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, wherein the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.*

The Examiner takes the position that Horan-Weingardt teaches all the features recited in Claim 29. Specifically, the Examiner asserts that Horan teaches "associating at least one of the set of graphics to rows on the bingo card," as recited by Claim 29. As evidence for his position, the Examiner points to Weingardt at Column 1, lines 31-40, and Column 7, lines 15-24. As already discussed above, the first excerpt of Weingardt merely describes some of the well known patterns that can be used as game winning patterns in bingo. Weingardt states, for example, that in "the conventional manner of play of bingo, in order to win the game, a player must cover five spaces in a vertical column, a horizontal row or along one of the two diagonals of the bingo card.

[. . .] Other winning combinations include the four corners of the bingo card and the eight numbers immediately adjacent and surrounding the free space. Winning combinations can also include the covering of spots on the bingo card so that letter symbols are formed such as an X, U, L, H or T.” *Weingardt* at Column 1, lines 31-40. At Column 7, lines 15-24, Weingardt simply states that additional colors can be used beyond the four used in the exemplary embodiments of Weingardt. Nowhere does Weingardt render obvious “*associating at least one of the set of graphics to rows on the bingo card.*”

Again, as already discussed above, the Examiner appears to take the position that any variations of bingo in which colors, numbers, patterns, etc., are involved would be obvious over Weingardt’s general references to winning patterns (including columns and rows) and association of colors with randomly selected numbers. Applicant submits that the Examiner, relying on Weingardt, has failed to make a *prima facie* case for obviousness of Claim 29. Consequently, Applicant respectfully requests that the Examiner’s rejection of Claim 29 be reversed. Claims 30, 34-36, and 50-52 depend directly or indirectly from Claim 29; hence, Applicant submits that Claims 30, 34-36, and 50-52 are also allowable over the references of record.

**VI. The Examiner’s final rejection of Claim 31 under 35 U.S.C. § 103(a) should be reversed because the prior art cited does not teach or render obvious each and every limitation of Claim 31.**

Claim 31, depending from Claim 29, calls for “*selecting at least one number at random from each of the subsets to serve as a win enhancement activator; paying [. . .] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator; and paying [. . .] the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.*” The Examiner adopts the position that Horan-Weingardt teaches all of the features recited in Claim 31. *FOA* at page 5. More specifically, the Examiner alleges that Weingardt teaches or renders obvious “selecting at least one number at random from each of the subsets to serve as a win enhancement activator,” then paying first and second bonuses only if a winning pattern includes the enhancement activator. In support of his position, the Examiner offers Weingardt at Column 6 (lines 42-62), Column 7 (lines 44-65), and Column 8 (lines 9-20).

However, the first cited excerpt of Weingardt only describes the association of colors with groups of randomly selected numbers (e.g., “the conventional random number generator randomly selects from the seventy-five number set two groups of bingo numbers to be designated as the first specially designated numbers and the second specially designated numbers. [ . . . ] a total of between nine and fifteen of the bingo numbers [ . . . ] are predetermined to be the ‘green’ numbers.” *Weingardt* at Col. 6, lines 42-49.). The other two excerpts of Weingardt generally describe the use of “progressive jackpots.” In the context of progressive jackpots as described by Weingardt, once a first jackpot is won, certain players might be eligible to seek a subsequent jackpot in the same game. However, that notion is different from the subject matter of Claim 31, in which a first bonus is awarded if a column contains a win enhancer and a second bonus is awarded if a row contains a win enhancer. To further elucidate, the awarding of the second bonus in Claim 31 is not dependent on the awarding of the first bonus, which is to be contrasted to the notion of progressive jackpots discussed in Weingardt.

Thus, Applicant submits that Weingardt does not support the Examiner’s prima facie case of obviousness of Claim 31. Applicant respectfully requests that the Examiner’s final rejection of Claim 31 be reversed.

**VII. The Examiner’s final rejection of Claim 55 under 35 U.S.C. § 103(a) should be reversed because the prior art cited does not teach or render obvious each and every limitation of Claim 55.**

At page 7 of the *FOA*, the Examiner rejected Claim 55 as obvious over Horan-Weingardt. For the following reasons, Applicant submits that Claim 55 is allowable over Horan and Weingardt, singly or in combination.

Independent Claim 55 is directed to a method of playing a bingo game. The method involves, in relevant part:

- (c) associating each of [a] plurality of subsets [of potential numbers] with at least one bingo card column;
- (e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;
- (f) providing at least a first set of colors;
- (g) associating each of the first set of colors with a win enhancement

*value;*

*(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column;*

*(i) designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;*

*(j) providing a set of graphics;*

*(k) associating each of the set of graphics with a win enhancement value;*

*(l) associating at least one of the set of graphics to rows on the bingo card;*

*(m) selecting at least one number at random from each of the subsets to serve as a win enhancement activator;*

*(o) paying [ . . . ] a win value if [ . . . ] a bingo card [has] numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern;*

*(p) paying, in addition to the win value, a first bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs; and*

*(q) paying, in addition to the win value, a second bonus [if] a bingo card [has] numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.*

As can be seen, independent Claim 55 brings together many of the features recited in various other independent and dependent claims previously argued as being patentable over the Horan-Weingardt combination. Hence, the Examiner took the position that all the features of Claim 55 were obvious over the Horan-Weingardt combination, and reinstated the same reasons for rejection as used with other claims.

Applicant submits, however, that it is impermissible for the Examiner to atomize Applicant's claim, purport to identify in the prior art each atom of a whole claim, and then combine the atoms together with little rationale of a logical nexus between the atoms. In other words, the Examiner must consider Claim 55 as a whole. As stated in the MPEP, "USPTO

personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” 2106.II.C. (*citing*, *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

Somewhat simplifying, Claim 55 recites association of colors with columns without regard to the numbers associated with a given column, association of graphics with rows, selection of win enhancers, and different payouts in the same game depending on whether a winning pattern is associated with a given color, graphic, and/or win enhancer. While Horan describes winning patterns of numbers, and Weingardt teaches association of colors with randomly selected numbers, nowhere does the Horan-Weingardt combination teach or render obvious a bingo game as recited by Claim 55. As previously argued, not only does the Horan-Weingardt combination fail to teach or render obvious numerous features of Claim 55, but additionally, Weingardt teaches away from various aspects of Claim 55. Specifically, for example as previously discussed with reference to Claim 27 above, the operating principle of Weingardt would have to be impermissible changed to arrive at the feature of Claim 55 directed to “*associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column.*”

Therefore, Applicant submits that the Horan-Weingardt combination does not support a *prima facie* case of obviousness, and that Claim 55 is allowable over Horan and Weingardt, singly or in combination. Applicant respectfully requests that the Examiner’s final rejection of Claim 55 be reversed.

## CONCLUSION

Applicant has made diligent efforts to advance the prosecution of this application by pointing out with specificity the error in the Examiner's rejections and the claim language that renders the invention patentable over the prior art of record. Accordingly, Applicant respectfully request that the final rejection of Claims 27-52 and 55 be reversed.

Respectfully submitted,

  
Johnfar Kerlee  
Reg. No. 53,111  
DILLON & YUDELL LLP  
8911 N. Capital of Texas Highway  
Suite 2110  
Austin, Texas 78759  
512-617-5516

ATTORNEY FOR APPLICANT

## CLAIMS APPENDIX

1-26. (canceled)

27. A method of playing a game of bingo comprising:

(a) designating a set of potential numbers for the game;

(b) designating a plurality of subsets of the potential numbers for the game;

(c) associating each of the plurality of subsets with at least one bingo card column;

(d) providing at least one bingo card to at least one player, the bingo card including a plurality of spaces, the spaces being arranged in a matrix of rows and columns, wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator;

(e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;

(f) providing at least a first set of colors;

(g) associating each of the first set of colors with a win enhancement value;

(h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column;

(i) repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends;

(j) paying the at least one player a win value if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern; and

(k) paying, in addition to the win value, a first bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern, wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.

28. The method of claim 27, further comprising:

selecting at least one number at random from each of the subsets to serve as a win enhancement activator; and

paying the at least one player the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.

29. The method of claim 27, further comprising:

designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;

providing a set of graphics;

associating each of the set of graphics with a win enhancement value;

associating at least one of the set of graphics to rows on the bingo card; and

paying a second bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, wherein the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.

30. The method of claim 29, further comprising:

selecting at least one number at random from each of the subsets to serve as a win enhancement activator; and

paying the at least one player the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.

31. The method of claim 29, further comprising:

selecting at least one number at random from each of the subsets to serve as a win enhancement activator;

paying the at least one player the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator; and

paying the at least one player the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator.

32. The method of claim 27, wherein the first pattern of spaces includes a pattern of contiguous spaces on the bingo card.
33. The method of claim 32, wherein the first pattern includes a column of spaces on the bingo card.
34. The method of claim 29, wherein the second pattern includes a pattern of contiguous spaces on the bingo board.
35. The method of claim 34, wherein the second pattern further includes a horizontal row of spaces on the bingo board.
36. The method of claim 29, wherein the first pattern or the second pattern includes a diagonal pattern of contiguous spaces on the bingo card.
37. The method of claim 27, wherein the first pattern includes noncontiguous spaces on the bingo card.
38. The method of claim 27, wherein the random numbers are generated by selecting a ball having a number printed on it from a plurality of balls.
39. The method of claim 38, wherein the bingo card is maintained and displayed electronically by a card tending device.
40. The method of claim 39, wherein the number associated with the randomly selected ball is manually entered into the card tending device by the player.
41. The method of claim 39, wherein the at least one bingo card is marked by the player interacting with the card tending device.

42. The method of claim 27, wherein the at least one bingo card is maintained and displayed electronically by a card tending device.

43. The method of claim 29, wherein the random numbers are generated by a computing device and communicated to the card tending device.

44. The method of claim 27, wherein the win enhancement value is a progressive prize.

45. The method of claim 44, wherein the progressive prize is incremented at an accelerated rate.

46. The method of claim 44, wherein the progressive prize is incremented to reflect live updating of the prize amount.

47. The method of claim 27, wherein each of the columns is assigned a unique color.

48. The method of claim 27, wherein at least three of the columns are assigned the same color.

49. The method of claim 27, wherein at least the column closest to the middle of the matrix is assigned a unique color.

50. The method of claim 29, wherein each of the rows is assigned a unique graphic.

51. The method of claim 29, wherein at least three of the rows are assigned the same graphic.

52. The method of claim 29, wherein at least the row closest to the middle of the matrix is assigned a unique indicator.

53-54. (canceled)

55. A method of playing a bingo game, comprising:
- (a) designating a set of potential numbers for the game;
  - (b) designating a plurality of subsets of the potential numbers for the game;
  - (c) associating each of the plurality of subsets with at least one bingo card column;
  - (d) providing at least one bingo card to at least one player, the bingo card including a plurality of spaces, the spaces being arranged in a matrix of rows and columns, wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator;
  - (e) designating at least one first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern includes at least a column of spaces on the bingo card;
  - (f) providing at least a first set of colors;
  - (g) associating each of the first set of colors with a win enhancement value;
  - (h) prior to performing step (c), associating at least one of the first set of colors to at least one column without regard to the associated subset of potential numbers for the at least one column;
  - (i) designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game, wherein the second pattern includes at least a row of spaces on the bingo card;
  - (j) providing a set of graphics;
  - (k) associating each of the set of graphics with a win enhancement value;
  - (l) associating at least one of the set of graphics to rows on the bingo card; and
  - (m) selecting at least one number at random from each of the subsets to serve as a win enhancement activator;
  - (n) repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends;
  - (o) paying the at least one player a win value if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern;
  - (p) paying, in addition to the win value, a first bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential

numbers, if the pattern formed by the matching numbers matches the at least one first pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs; and

(q) paying, in addition to the win value, a second bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, and if the pattern formed by the matching numbers contains at least one win enhancement activator, wherein the value of the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs.

56-79. (canceled)

## **EVIDENCE APPENDIX**

Other than the Office Actions and replies already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

## **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Applicant, Applicant's legal representative, or assignee.